

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 72

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte EDDIE D. DUKE

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Appeal No. 2001-0961  
Application No. 08/108,133

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ON BRIEF

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Before JERRY SMITH, BARRETT and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of the following design claim:

The ornamental design for a hollow container for displaying articles contained therein as shown and described.

The hollow container design is generally in the form of a transparent cube as best depicted in Figures 1-4. The container displays a ball as shown in Figures 1 and 2.

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The examiner relies on the following references:

LaPine Scientific Company Catalogue, 1965, Octrahedron in Cube (item no. Z-9074), page 8, and Cone, Parabolic Section and Sphere (item no. Z-9081), page 13.

The design claim stands rejected under 35 U.S.C. § 103 as being unpatentable over the first cited item from the LaPine catalogue in view of the second cited item from the catalogue.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill of the designer in this particular art would not have suggested to the

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designer of ordinary skill in the art the obviousness of the design claim before us. Accordingly, we reverse.

Initially, we point out that in a proper rejection of a design claim under 35 U.S.C. § 103, there is the requirement that there must be a reference (the basic design), a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness. In other words, the basic reference design must look something like the claimed design. See In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993) and In re Rosen, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982). Once such a basic design reference has been established, features thereof might reasonably be modified to achieve the claimed design. Such modifications, however, cannot destroy fundamental characteristics of the basic design reference.

We also keep the following principles clearly in mind when evaluating the obviousness of a claimed design. The proper standard under 35 U.S.C. § 103 is whether the design would have been obvious to a designer of ordinary skill of the articles involved. Note In re Nalbandian, 661 F.2d 1214, 1216, 211 USPQ 782, 784 (CCPA 1981). Further it is the overall appearance of a design, that is the visual effect as a whole of the design, which

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must be taken into consideration. In re Rosen, supra. However, while the obviousness of a design must be evaluated as a whole, the evaluation of the whole necessarily involves consideration of what are indicated to be the distinguishing features of the claimed design. See Petersen Manufacturing Co., Inc. v. Central Purchasing, Inc., 740 F.2d 1541, 1548, 222 USPQ 562, 567 (Fed. Cir. 1984). Additionally, when considering the patentability of a design, the mere fact that there are differences between the design and a prior art design is not alone sufficient to justify the patentability of the design. In re Lamb, 286 F.2d 610, 611, 128 USPQ 539, 539 (CCPA 1961). It is the distinctiveness in overall appearance of a design when compared to a prior art design, rather than minute details or small variations in configuration, which constitutes the test for design patentability. In re Lapworth, 451 F.2d 1094, 1096, 172 USPQ 129, 131 (CCPA 1971).

We now consider how these principles and the arguments made by appellant and the examiner affect our decision based upon the record before us.

The examiner has pointed out why he finds that the overall appearance of the claimed design would have been obvious to the designer of ordinary skill in view of the teachings of the two

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items from the LaPine catalogue [answer, pages 2-3].

Appellant argues that the Octrahedron in Cube item is not a proper primary reference because it has a design which is very different from the claimed design and, thus, does not have an overall visual impression that is basically the same as the claimed design. Appellant also argues that the two reference items contain no hint or suggestion to apply a feature of one to the other. Appellant notes that the visual appearance of the two items is very different. Appellant argues that the reference items are non-analogous art because they are mathematical teaching aids and have nothing to do with a sports ball display. Finally, appellant argues that he submitted evidence that the claimed invention satisfied a long-felt but unsolved need of sports enthusiasts, but the examiner has failed to consider or discuss such evidence [brief, pages 3-12].

The examiner responds that the reference items are analogous and that the primary reference presents the overall appearance of the claimed design [answer, page 4].

We do not sustain the examiner's rejection of the design claim on appeal for the reasons essentially argued by appellant in the brief. There is no similarity in visual appearance between the claimed design and the two reference items. It is

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quite apparent that the examiner has selectively picked and chosen individual features from each of the reference items and combined them in a manner to recreate the claimed invention in hindsight. We agree with appellant that the designer of ordinary skill would not have been motivated to combine the applied references to arrive at the claimed invention.

We also note for the record that the examiner erred in failing to address the objective evidence of non-obviousness as set forth in the declaration filed by Kenneth Rogers. As noted by appellant and as set forth in the MPEP § 1504.04, the examiner must consider objective evidence of non-obviousness when it is presented. Failure to consider such evidence would be grounds by itself to reverse the examiner's rejection.

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In summary, we have not sustained the examiner's rejection of the design claim on appeal. Therefore, the decision of the examiner rejecting the claim on appeal is reversed.

REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
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	)	
LEE E. BARRETT	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
HOWARD B. BLANKENSHIP	)	
Administrative Patent Judge	)	

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